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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,074

06/23/2006

Thomas Scherb

P28845

9642

7055 7590 05/21/2009
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1950 ROLAND CLARKE PLACE
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EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

05/21/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/560,074	Applicant(s) SCHERB ET AL.	
	Examiner José A. Fortuna	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 162-274 is/are pending in the application.
- 4a) Of the above claim(s) 162-223 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 224-274 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group II, (the device claims) and specie of formers, in the reply filed on March 16, 2009 is acknowledged. The traversal is on the ground(s) that that the examiner ignored that all of the groups have a common technical feature and therefore as the application is a national stage application, i.e., a 371 case, there is no lack of unity. This is not found persuasive because the groups even if they contain the same technical feature could lack of unity if that common technical feature does not make a contribution over the prior art and that was the principle of the restriction. The MPEP in the LACK OF Unity of an invention section 1800 state as follows, (Emphasis Added):

II. DETERMINATION OF "UNITY OF INVENTION"

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any). Whether or not any particular technical feature makes a "contribution" over the prior art,

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and therefore constitutes a “special technical feature,” should be considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Lack of unity of invention may be directly evident “a priori,” that is, before considering the claims in relation to any prior art, or may only become apparent “a posteriori,” that is, after taking the prior art into consideration. For example, independent claims to A + X, A + Y, X + Y can be said to lack unity a priori as there is no subject matter common to all claims. In the case of independent claims to A + X and A + Y, unity of invention is present a priori as A is common to both claims. However, if it can be established that A is known, there is lack of unity a posteriori, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art.

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the

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remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant. From the preceding paragraphs it is clear that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. However, the International Searching Authority or the International Preliminary Examining Authority should not raise objection of lack of unity of invention merely because the inventions claimed are classified in separate classification groups or merely for the purpose of restricting the international search to certain classification groups.

With regard to the specie restriction, applicants misunderstood the restriction. Applicants were suppose to elect a specie from the claim discussed, e.g., one transfer device from claim 227, one rewetting and drying technique of claim 231, etc. For the advancing of the prosecution of the case, the specie restriction would be withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 162-223 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on March 16, 2009

Claim Objections

3. Claims 240 and 264 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear how the basis weight and tensile strength of the product, further limits the structure of the device.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

5. Figure 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 232, 252-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 232, 252-253 are vague and indefinite as to the drying by a drying hood, i.e., the claims seems to imply a drying hood by itself and hoods are associated to another device, usually a drying cylinder, which is covered by the hood. Therefore, the claims are vague and indefinite since they are incomplete, for failing to identify the other part of the drying system.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

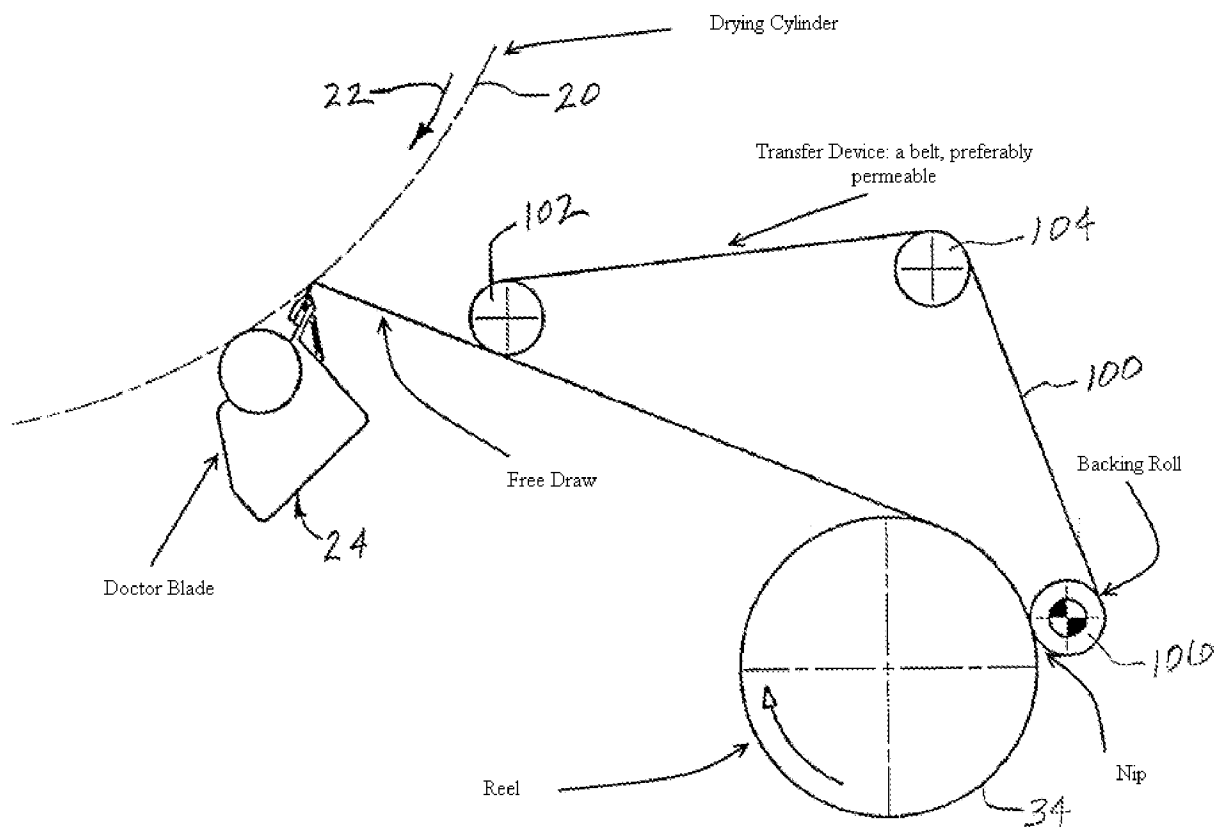
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 224, 226-229, 231-234, 236-237, 240-241, 243, 246, 247-248, 250, 252, 254-256, 260, 264-266, 268-270 and 274 are rejected under 35 U.S.C. 102(b) as being anticipated by Linden, US Patent Application Publication No. 2002/0060036 A1.

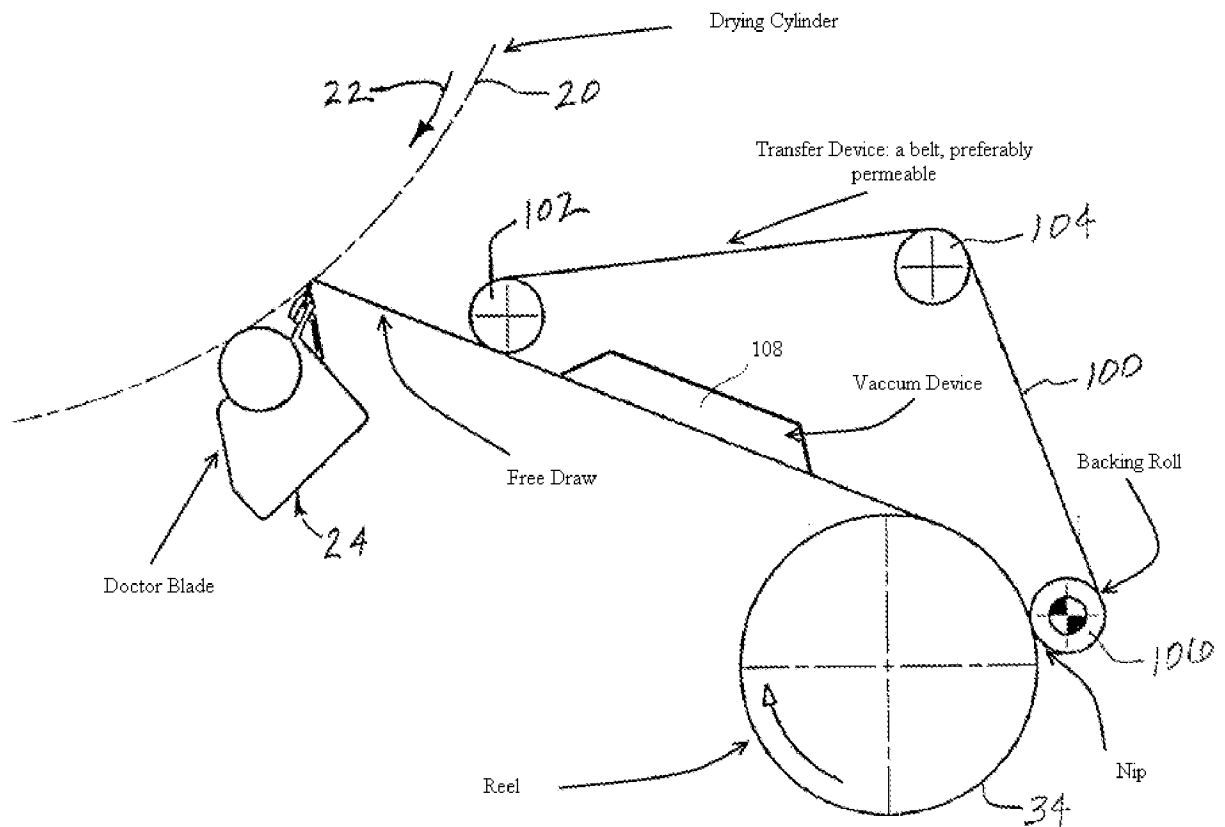
Linden teaches a device for producing a tissue web which includes a drying cylinder that could be a Yankee Dryer, a creping Doctor and winding device to reel-up the web onto a roll and a transfer device that carries the web from almost the entire run from the doctor blade to the winding roll, see figure 7B and ¶-[0053]. The figure shows also that the web is unsupported, creating a free draw from short distance from the doctor to the beginning of the transfer device, and shows that the web is supported on one side of the transfer

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device. Linden shows also that the device can include a nip, formed by a backing roll and the reel, see for example ¶-[0053]. Figure 7F shows an embodiment in which the web is formed using a crescent former and through-air-dried (TAD) having hoods. Linden teaches also that the transfer device can be a belt; preferably a permeable belt and that vacuum can be applied to the web through the permeable belt. The device can be a vacuum box or a device that creates under pressure by blowing air via the Coanda effect, ¶-[0053] and Figures 7B and 7C, see below:



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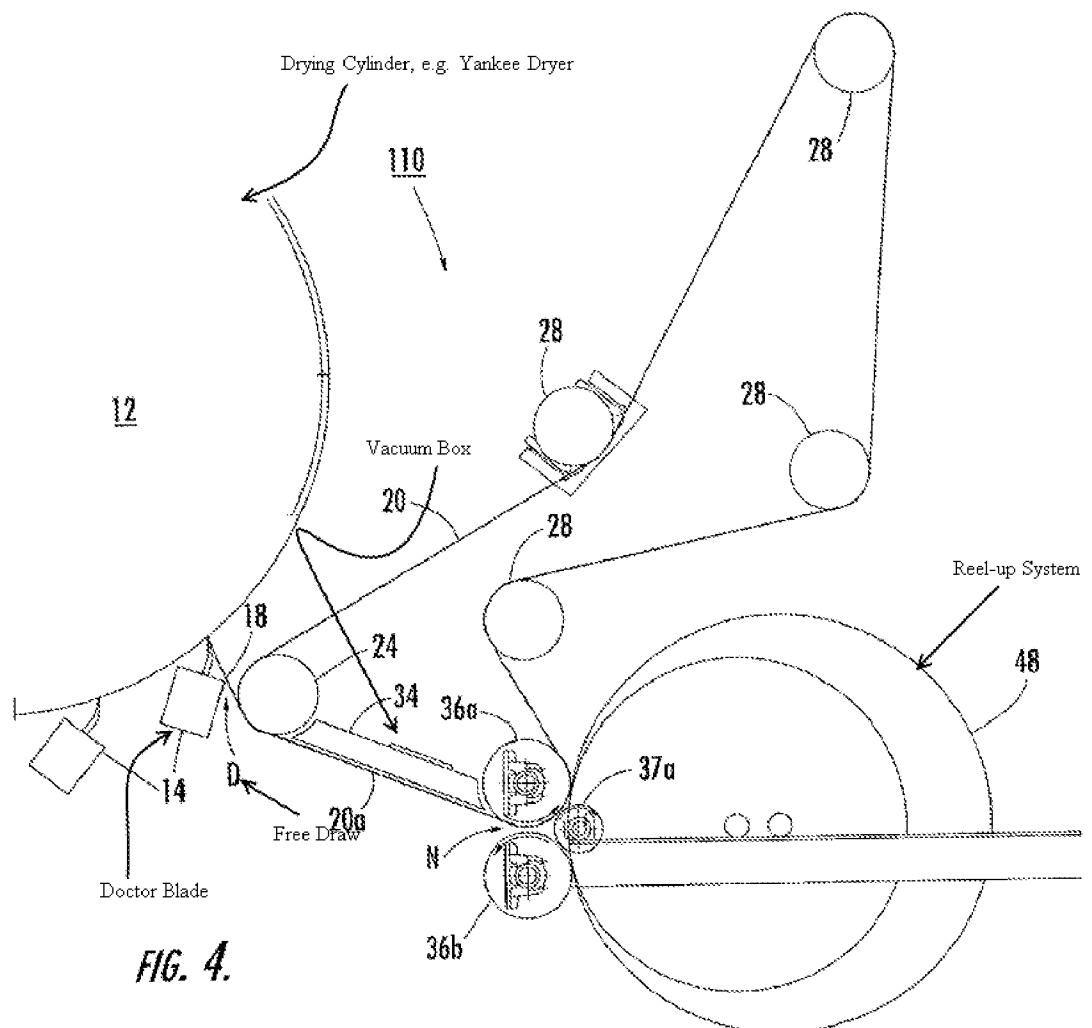
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 224-229, 231-237, 240-241, 243, 255-256, 259-260, 264, 269 and 274 are rejected under 35 U.S.C. 102(e) as being Anticipated by Clarke et al., US Patent Application Publication No. 2000/0111199 A1.

Clarke et al. teach a device for producing a tissue web which includes a drying cylinder, that could be a Yankee Dryer, a creping Doctor and winding device to reel-up the web onto a roll and a transfer device that carries the web from almost the entire run from the

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doctor blade to the winding roll, see figures, specially figure 4, and ¶-[0036]-[0038]. The figure show also that the web is unsupported, creating a free draw from short distance from the doctor to the beginning of the transfer device, and show that the web is supported on one side of the transfer device. Clarke teach also that the short Draw, (D) can be changed from 4 inches to 48 inches, (0.1 to 1.20 meters), which falls within the claimed range, see ¶-[0024]. Clarke et al. show also that the device can include a nip formed by a backing roll and the reel, see figure 4 and ¶-[0036]-[0038]. Clarke et al. teach also that the transfer device can be a belt; preferably a permeable belt and that vacuum can be applied to the web through the permeable belt. The device can be a vacuum box (34) or a device that creates under pressure by blowing air via the Coanda effect, ¶-[0030]-[00333] and Figures 4, below:

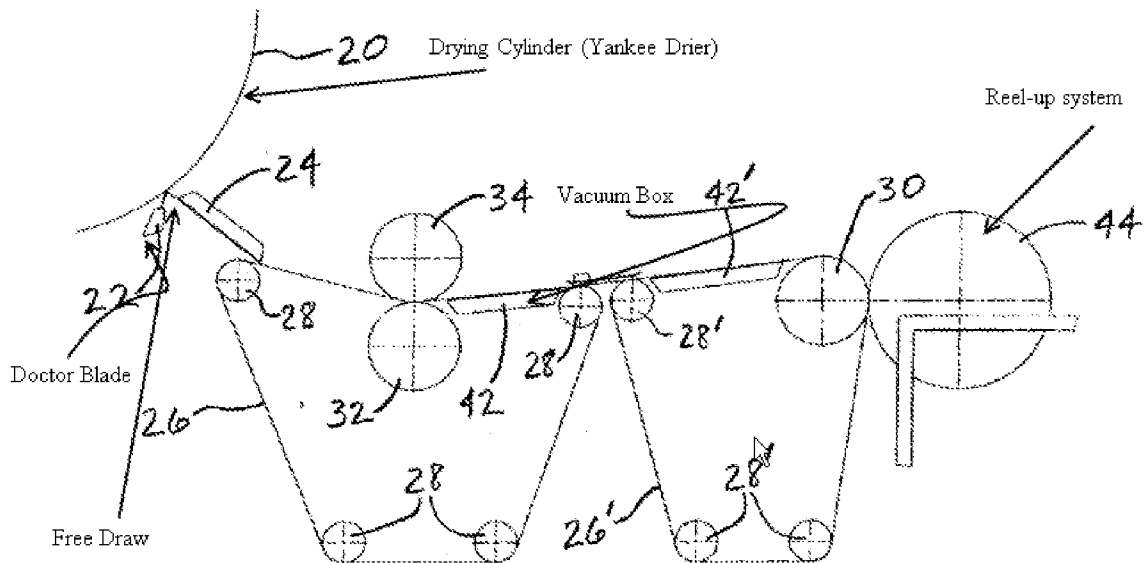


(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 224, 226-229, 231-234, 236-237, 240-241, 243, 246-248, 250, 252, 254-257, 260-261, 264-266, 268-270 and 274 are rejected under 35 U.S.C. 102(e) as being anticipated by Klerelid et al., US Patent Application Publication No. 2003/0221807 A1.

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Klerelid et al. teach a device for producing a tissue web which includes a drying cylinder, that could be a Yankee Dryer, a creping Doctor and winding device to reel-up the web onto a roll and a transfer device that carries the web from almost the entire run from the doctor blade to the winding roll, see figures 1-21 and ¶-[0005]-[0014]. The figures show also that the web is unsupported, creating a free draw from short distance from the doctor to the beginning of the transfer device, and shows that the web is supported on one side of the transfer device. Klerelid et al. show also that the device can include a nip, formed by a backing roll and the reel, see for example figure 21, and ¶-[0069]. Klerelid et al. teach that the lineal pressure at the winding nip is controlled to be between 100-250 N/m (0.1 kN/m- 0.250 kN/m), ¶-[0071]. Klerelid et al. teach also that the transfer device can be a belt; preferably a permeable belt and that vacuum can be applied to the web through the permeable belt. The device can be a vacuum box or a device that creates under pressure by blowing air via the Coanda effect, ¶-[0040] and Figures 1-21, see figure 21 below:

**FIG. 21*****Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 230, 238-239, 242, 244-254, 257-258, 261-263, 265-268, 270-273 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al., cited above.

Clarke et al. invention has been already explained *supra*. They are silent with regard to the limitations of the above claims, e.g., the use of a multilayered headbox and its different modifications or the use of crescent formers, nor the specifics of the reel-up system, i.e., the control system, nor the use of a pulper underneath the reel-up or the drying machine. However all of those limitations are well known in the art as evidenced by the supplied prior art, see PTO-Form-892, attached. Since the use of the claimed devices are conventional in the art, their use is within the levels of ordinary skill in the art, since he/she would have reasonable expectation of success if such devices were to be used in the system taught by Clarke et al. It has been held that it is obvious to try, choosing from a finite number of identified, predictable solutions with a reasonable expectation of success. See recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (Citing KSR, 82 USPQ2d at 1396).

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16. Claims 225, 230, 235, 238-239, 242, 244-245, 249, 251, 253, 257-259, 261-263, 267 and 271-273 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden, (cited above), in view of Clarke et al., (cited above).

Linden. invention has been already explained *supra*. They are silent with regard to the limitations of the above claims, e.g., the use of a multilayered headbox and its different modifications or the use of crescent formers, nor the specifics of the reel-up system, i.e., the control system, nor the use of a pulper underneath the reel-up or the drying machine. However all of those limitations are well known in the art as evidenced by the supplied prior art, see PTO-Form-892, attached. Since the use of the claimed devices are conventional in the art, their use is within the levels of ordinary skill in the art, since he/she would have reasonable expectation of success if such devices were to be used in the system taught by Linden. It has been held that it is obvious to try, choosing from a finite number of identified, predictable solutions with a reasonable expectation of success. See recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (Citing KSR, 82 USPQ2d at 1396). Note that even though Linden does not explicitly teach the length of the short free draw, Clarke et al., teach that the optimal free draw lays between 4 to 48 inches (0.1 m to 1.2 m) and therefore, using such length would have been obvious to one of ordinary skill in the art, absent a showing of unexpected results.

17. Claims 225, 230, 235, 238-239, 242, 244-245, 249, 251, 253, 258-259, 262-263, 267, and 271-273 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klerelid et al., (cited above), in view of Clarke et al., (cited above).

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Klerelid et al. invention has been already explained *supra*. They are silent with regard to the limitations of the above claims, e.g., the use of a multilayered headbox and its different modifications or the use of crescent formers, nor the specifics of the reel-up system, i.e., the control system, nor the use of a pulper underneath the reel-up or the drying machine. However all of those limitations are well known in the art as evidenced by the supplied prior art, see PTO-Form-892, attached. Since the use of the claimed devices are conventional in the art, their use is within the levels of ordinary skill in the art, since he/she would have reasonable expectation of success if such devices were to be used in the system taught by Klerelid et al. It has been held that it is obvious to try, choosing from a finite number of identified, predictable solutions with a reasonable expectation of success. See recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (Citing KSR, 82 USPQ2d at 1396). Note that even though Linden does not explicitly teach the length of the short free draw, Clarke et al., teach that the optimal free draw lays between 4 to 48 inches (0.1 m to 1.2 m) and therefore, using such length would have been obvious to one of ordinary skill in the art, absent a showing of unexpected results.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Device for Winding a Tissue Web."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF